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Total Number of Pages in This Submission: 26

Application Number	09/636,418
Filing Date	August 10, 2000
First Named Inventor	Axe, Christopher E.
Art Unit	2178
Examiner Name	Gregory J. Vaughn
Attorney Docket Number	021756-018700US

ENCLOSURES *(Check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☐ Amendment/Reply
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  - ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
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- ☐ Information Disclosure Statement
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- ☐ Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):

Appellant's Reply Brief Under 37 C.F.R. §41.41 in triplicate (8 pages x 3);
This Transmittal Form (1 page); and
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Townsend and Townsend and Crew LLP		
Signature	David Raczkowski		
Printed name	David B. Raczkowski		
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TOWNSEND and TOWNSEND and CREW LLP

By: Sushma Sanganeria-Brady
Sushma Sanganeria-Brady

PATENT
Attorney Docket No. 021756-018700US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Confirmation No. 6284
Christopher E. AXE	Examiner: Gregory J. Vaughn
Application No.: 09/636,418	Technology Center/Art Unit: 2178
Filed: August 10, 2000	**APPELLANT'S REPLY BRIEF UNDER 37 CFR §41.41**
For: VISUAL CONFIGURATOR	
Customer No.: 51206	

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Sir:

Appellants offer this Reply Brief in response to the Examiner's Answer mailed on February 10, 2006. The following remarks are intended to further focus the issues in this appeal.

I. Status of Claims

Claims 1-35 are pending in this application.

Claim 34 is rejected under 35 U.S.C. 112, ¶ 1, as failing to comply with the written description requirement.

Claim 34 is rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claims 1-3, 6-9, 14-17, 23-30, and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Henson, US Patent 6,167,383 (filed 09/22/1998).

Claims 4, 5, 11-13 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

Claims 10, 21, 22, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al., US Patent 6,161,114 (filed 4/14/1999).

II. Grounds of Rejection to be Reviewed on Appeal

Issue 1: Whether Claim 34 was properly rejected under 35 U.S.C. 112, ¶ 1, as failing to comply with the written description requirement.

Issue 2: Whether Claim 34 was properly rejected under 35 U.S.C. 101 as being directed to nonstatutory subject matter.

Issue 3: Whether Claims 1-3, 6-9, 14-17, 23-30, and 32-34 were properly rejected under 35 U.S.C. 102(b) as being anticipated by Henson, US Patent 6,167,383 (filed 09/22/1998).

Issue 4: Whether Claims 4, 5, 11-13 and 18-20 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over Henson.

Issue 5: Whether Claims 10, 21, 22, 31 and 35 were properly rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of King et al. US Patent 6,161,114 (filed 4/14/1999).

III. Argument

In the Examiner's Answer, the prior art rejections were maintained and additional comments were presented in response to the Appeal Brief filed November 14, 2005. Addressed Rejections are presented in the order of the Examiner's Answer. Applicants stand on other arguments presented in the Appeal Brief.

A. Claim 1 - Rejection under 35 U.S.C. § 102, Henson

Claim 1 recites "*receiving a selection of one of the plurality of selectable objects, and of one of the plurality of slots in which **the selected object** may be placed*." The Examiner has held that Henson's Figure 3A which shows options in a designated slot as anticipating this claim element. "Also shown in Figure 3A are selectable objects (shown as dropdown list boxes) where a selection can be made for the designated slot." *See Answer*, page 6 lines 8-10. Thus, the Examiner has acknowledged that Henson teaches that an object is in one slot, as an option has a designated slot. In contrast, claim 1 recites a "plurality of slots in which **the selected object** may be placed."

Additionally, an interpretation that the claim only requires one slot in which the selected object may be placed would eliminate the claim limitation of selecting a slot. A court "must give meaning to all the words in [the] claims." *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1557, 35 USPQ2d 1801, 1804 (Fed. Cir. 1995). If there is only one slot in which the object may be placed, then there is no selection of a slot. Accordingly, because Henson does not teach or suggest that an object may be placed into more than one slot, claim 1 is allowable for at least this reason.

B. Claim 2 - Rejection under 35 U.S.C. § 102, Henson

First, there is a need to clarify the use of terms. The Examiner has interpreted the term "constraint" to be a "slot," a "selectable component," and possibly a "rule" all at the same time. For example, "[t]he constraint categories (shown as "Memory", "Hard Drive", "Monitor',

"Video Card" etc.) are each represented by a dropdown list box selection slot." *See Answer*, Page 8 line 9. A constraint, a slot, and a selectable component are separate claim terms. As noted above each claim term must be given meaning.

A constraint denotes "which combination of components can be selected" based on properties that "make the component incompatible for use with other components." S*ee Specification*, page 2, lines 1-2. As the components or the slots do not directly convey compatibility information, the components or slots cannot be constraints.

The Examiner states that the cart stores the constraints. *See Answer*, page 8 line 1. The cart stores a product, which is made of selectable components. *See Henson*, col. 17 lines 16-17. Thus, the cart does not store a set of constraints. In contrast, claim 2 recites "storing a new set of constraints."

The Examiner also states that Henson discloses that after a user selects a component "a new set of constraints is stored relative to the other dropdown list box selections." *See Answer*, Page 8 lines 10-12 (note that the Examiner equates a memory value component with a constraint). However, the Examiner does not point to where Henson discloses this limitation.

Although it is true that Henson teaches a compatibility warning, Henson does not teach or suggest how the compatibility issues are determined, or if there is a need to store a new set of constraints. The compatibility rules may be contained in a single file, which does not change during a configuration. This is more likely, given that Henson has fewer configurability options than the present invention.

Accordingly, because Henson does not teach or suggest storing a new set of constraints, claim 2 is allowable for at least this reason.

C. Claim 16 - Rejection under 35 U.S.C. § 102, Henson

The Examiner contends that in Figure 3A the option compatibility warning 86 is "generated during an attempted placement of the selected object in the selected slot." *See Answer*, page 10, lines 6-7. However, in Figure 3A, the Video Card option, which the warning 86 associates, clearly shows that the incompatible video card has already been placed in the slot

for the Video Card. The warning appears after a selection (placement), and not during an attempted placement. Note that the Examiner's equating the terms "selecting" and "placement" has been adopted here for clarity of presentation.

Thus, Henson allows any selection to be made and does not prevent selection (placement) of the object, but only indicates incompatibility after selection. On the contrary, claim 16 recites that the interface "*indicate[s] that the selected object cannot be placed in the selected slot.*" Accordingly, because Henson does not teach or suggest this limitation, claim 16 is allowable for at least this reason.

D. Claim 29 - Rejection under 35 U.S.C. § 102, Henson

The Examiner states that Figure 5 is a first configuration. *See Answer*, page 13 line 1. In Figure 5 ("all options view"), each option has placed under it a list 92, which displays all of the possible selections for each option. All of the possible selections are already placed within each list. Thus, the placements do not change, and therefore there is no second configuration where the placement is limited. In contrast, claim 29 recites a second configuration with "*the placement of the first of the plurality of objects in the first of the one or more slots being limited by a subset of the plurality of configuration rules.*" Accordingly, because Henson does not teach or suggest that the placement is limited, claim 29 is allowable for at least this reason.

Alternatively, if the choosing of an object is interpreted as a placement, then Henson does not show selecting an object for placement.

E. Claim 19 - Rejection under 35 U.S.C. § 103, Henson

Claim 19 recites "*a user intelligence stored on the client device.*" The Examiner interprets the "user intelligence" in claim 19 to be a "user." *See Answer*, page 16 line 16. A "user" is a human being, and the human's intelligence is not stored on the client device when the human is using the client device. The Examiner contends that a user's selecting of objects constitutes storing a user's intelligence on the client device. *See Answer*, page 16 lines 16-18.

The selection of objects is the result of the user intelligently choosing an object, but the user's intelligence still resides in the user's mind and has not been transferred. Accordingly, because Henson does not teach or suggest a user intelligence stored on the client device, claim 19 is allowable for at least this reason.

Additionally, from the discussion of claim 16, Henson only describes determining an incompatibility when the object is already in a slot. Thus, the user has already placed an object into the slot, and then the user receives a warning as to the incompatibility. In contrast, claim 19 recites that the user intelligence is used to "*determine if placing the selected object in the selected slot would violate one or more of the plurality of configuration rules.*" Accordingly, because Henson does not teach or suggest if placing an object violates a rule, claim 19 is allowable for at least this reason.

Furthermore, the determination of the incompatibility is done by the configurator 18, not the user. The configurator 18, which is contained within the commerce application 14, is included in the online store 10 on a remote server. *See Henson*, col. 4 lines 53-66 and Figure 2. Thus, the determination is done by the remote inference engine, and not by a user intelligence stored on the client device. Accordingly, because Henson does not teach or suggest determining by a user intelligence stored on the client device, claim 19 is allowable for at least this reason.

F. Claim 22 - Rejection under 35 U.S.C. § 103, Henson

Claim 22 recites "*wherein causing the graphical user interface to indicate that the selected object cannot be placed in the selected slot includes not allowing the dragged one of the plurality of objects to be dropped in the one of the one or more slots.*"

The Examiner contends that Figure 3A of Henson discloses this limitation. *See Answer*, page 18 lines 6-8. However, as discussed for claim 16, Figure 3A shows the object already placed within a slot. Thus, even if an object is incompatible, Henson allows the object to be dropped into a slot. Thus, Henson does not teach or suggest not allowing an object to be

dropped into a slot. Accordingly, prima facie obviousness has not been established, since each and every limitation in claim 22 is not shown as being taught or suggested by the cited art.

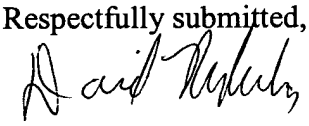
G. Claim 35 - Rejection under 35 U.S.C. § 103, Henson

Claim 35 recites "*while attempting to place the selected object in the selected slot.*" The Examiner points to col. 8 lines 7-24 of Henson, which describes a system warning and an option warning. *See Answer*, page 18 and 19. The option warning is placed next to the option that is incompatible. The particular selection for the option that is incompatible already appears in the slot, thus the warning comes after and not while the object is attempted to be placed. *See Henson*, Figure 3A. Accordingly, prima facie obviousness has not been established, since each and every limitation in claim 35 is not shown as being taught or suggested by the cited art.

CONCLUSION

Thus, for at least these reasons as well as the reasons stated in the Appellant's Appeal Brief, which are hereby incorporated by reference, it is believed that the above claims are entitled to allowance.

Respectfully submitted,



David B. Raczkowski
Reg. No. 52,145

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
DBR:dbr
60706000 v1